

## **REMARKS/ARGUMENTS**

### **Status of Claims**

Claims 1-14 are pending and currently amended. Support for the amendments can be found at least in paragraphs 00028 and 00029 of the specification section.

### **Rejection of claim 14 under 35 USC § 102(e) as being anticipated by Vallone (US 6642939)**

The Examiner maintains that Vallone anticipates claim 14.

Applicant submits that Vallone does not disclose, teach or suggest, expressly or inherently, claim 14.

Under 35 USC § 102, an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim. See MPEP § 2131.

Claim 14 recites a digital image device for generating digital still images, the digital image device comprising a first memory device for storing the digital still images, a display device for displaying the digital still images stored in said first memory device, a mode selection device for selecting a screen display mode to display the digital still images on the display device, a second memory device for storing an icon for indicating a still image display direction, and a processing device for controlling the operation to display the digital still images along with the icon, wherein the icon shows a forward direction or a backward direction according to the still image display direction.

Vallone merely discloses a multimedia schedule presentation with video display, wherein a trick play bar 2601 is overlaid onto live video (col 19, lines 28-35). Vallone does not disclose generating still images. Vallone merely discloses live video display (see col 19, lines 29-31) but does not disclose *digital still images*. Vallone only teaches image buttons of the trick play bar 2601 (see col 20, lines 22-50 of Vallone), but does not disclose *a mode selection device for selecting a screen display mode to display the digital still images on the display device*, as recited in claim 14.

Claim 14 describes displaying an icon for indicating image display direction, whereas Vallone discloses displaying on a trick play bar, a menu for indicating playback direction of

an MPEG stream (for example, rewind 2708, fast forward 2711-2713, pause 2714, or slow motion 2715). Specifically, Vallone's rewind 2708-2710 and fast forward 2711-2713 show the state when a stream is rewound or fast forwarded, respectively, but do not show a movement signal between images. For example, Vallone does not disclose displaying an inverse direction icon for indicating a movement direction if an inverse direction movement signal is input. Vallone displays the direction (rewind or forward) for selecting a playback location in a single stream, but does not display the direction when moving in a plurality of streams.

Furthermore, the Examiner admits that Vallone does not explicitly disclose that the icon is stored in memory and alleges that it would have been inherent to store icons because there is no other conceivable place to store the icon and the icon is clearly stored somewhere because it is displayed (see office action, bottom of page 4). The Examiner fails to provide any evidence to support the inherency. Applicant submits that it would not have been inherent to store the icon "somewhere" simply because it is displayed. Vallone itself exemplifies at least one scenario where a object can be displayed and not stored. Specifically, Vallone discloses a trick play bar with a cache bar, a slider and a timing mark with a mode indicator 2705 that is displayed (col 20, lines 51-60), however, the mode indicator is not stored.

Furthermore, the Examiner alleges, in the Response to Arguments section on page 2 of the office action, that there must necessarily be instructions for constructing images written in a memory and that it is inherent that the images (the icon) are stored in a memory. Applicant submits that having instructions in memory does not teach or even suggest, expressly or inherently *a memory device for storing an icon*.

Thus, Vallone fails to disclose *a memory device for storing an icon for indicating image display direction*, as claimed.

Applicant respectfully submits that the rejection under § 102 is improper at least because the Applicant shows (in the example above) that the features the Examiner purports to be inherent, are not inherent, thus precluding a rejection under § 102. Applicant respectfully requests that if the Examiner maintains the rejection, then the Examiner provide evidentiary support for the inherency and issue the next office action as non-final so that the Applicant has an opportunity to respond.

Claim 14 is allowable at least for this reason.

**Rejection of claims 1-7 and 9-12 under 35 USC § 103(a) as being unpatentable over Shioji (US US 7193646 B1) in view of Vallone (US 6642939)**

The Examiner maintains that claims 1-7 and 9-12 are unpatentable over Shioji in view of Vallone.

Applicant submits that Shioji and Vallone, alone or in any combination, do not disclose, teach or suggest, expressly or inherently, claims 1-7 and 9-12.

Exemplary embodiments of claim 1 relate to a digital image device for generating digital still images. For example, an icon is displayed for indicating a location between normal digital images.

Shioji does not disclose *at least one memory device for storing the digital still images and at least one icon for indicating still image display direction and a processing device programmable to control the retrieval of an icon from a memory device*, as recited in claim 1.

Shioji merely discloses a digital camera and method for classifying and reproducing images (see Abstract section of Shioji). Shioji's Fig 1, item 46 suggests a memory device and the mark "M" (as shown in Fig 6) that is merely a selection mark that is displayed on the reduced images. However, Shioji does not disclose *an icon that is stored in and retrieved from a memory device* according to Applicant's claims. Shioji's mark "M" is merely displayed on the display screen. Shioji discloses a selection mark M that indicates which image is selected from images A to I (see Fig 6 and col 8, lines 29-31 of Shioji), but does not indicate a selected direction, as recited in claim 1. In addition, Shioji merely discloses a selection mark, but does not disclose an icon corresponding to a different direction. For example, Shioji does not disclose *indicating one of a forward direction and a backward direction depending on whether said command selected the next digital still image and the previous digital still image, respectively, in the sequential display of the digital still images*, as recited in claim 1.

Furthermore, the Examiner admits that Shioji does not disclose that the arrow is either forward or backward depending on if the images are being selected in forward or backward order, and relies on Vallone to make up for Shioji's deficiencies. Applicant submits that Vallone fails to make up for Shioji's deficiencies at least because Vallone merely discloses playback of MPEG streams such as moving images, whereas Applicant's claims describe an icon that is displayed for indicating a location between digital images.

Additionally, on page 4 of the office action, the Examiner admits that Vallone does not explicitly disclose that the icon is stored in memory. Vallone discloses an object that can be displayed and not stored. Specifically, Vallone discloses a trick play bar with a cache bar, a slider and a timing mark with a mode indicator 2705 that is displayed (col 20, lines 51-60), however, the mode indicator is not stored. Thus, Vallone, alone or in any combination with Shioji, fails to disclose *at least one stored icon indicating still image display direction, wherein the stored icon indicates one of a forward direction and a backward direction depending on whether said command selected the next digital still image and the previous digital still image, respectively, in the sequential display of the digital still images*, as described in the claims. Shioji and Vallone, alone or in any combination, do not disclose, teach or suggest, expressly or inherently, claim 1. Accordingly, claim 1 is allowable.

Claims 2-7 are allowable at least because they depend from allowable base claim 1.

Claim 9 is allowable at least for reasons similar to claim 1.

Claims 10, 11 and 12 are allowable at least because they depend on allowable base claim 9.

**Rejection of claims 8 and 13 under 35 USC § 103(a) as being unpatentable over Shioji (US 7193646 B1) in view of Vallone (US 6642939) and further in view of English Abstract of JP 10-240218 (Takayanagi, cited in Applicant's IDS)**

The Examiner maintains that claims 8 and 13 are unpatentable over Shioji in view of Vallone and Takayanagi.

Applicant submits that Shioji, Vallone and Takayanagi alone or in any combination, do not disclose, teach or suggest, expressly or inherently, claims 8 and 13.

Shioji in view of Vallone does not disclose, teach or suggest claims 8 and 13 and that Takayanagi fails to make up for Shioji's and Vallone's deficiencies.

Additionally, claims 8 and 13 are allowable at least because they depend from allowable base claims 1 and 9, respectively.

Takayanagi merely discloses plotting icons and dynamically revising attitude, shape and color of an icon in order to efficiently utilize memory and processing speed. However, Takayanagi, alone or in any combination with Shioji and Vallone, does not teach *selectively rotating at least one icon for indicating image display direction on said display screen to indicate a forward direction icon and a backward direction icon depending on whether said*

*command selected the next digital still image and the previous digital still image, respectively, in the sequential display of the digital still images, as described in the claims.*

Accordingly, claims 8 and 13 are allowable.

**Conclusion**

In view of the above, it is believed that the above-identified application is in condition for allowance, and notice to that effect is respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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